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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,526	01/14/2000	Anthony M. Pilaro	12086	8505

7590 04/20/2004

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EXAMINER	
WILSON, JOHN J	

ART UNIT	PAPER NUMBER
3732	

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/483,526	PILARO ET AL.	
	Examiner	Art Unit	
	John J. Wilson	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 February 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7,8,19-27,30,31,50-58,79 and 84-124* is/are pending in the application.

4a) Of the above claim(s) *30,31 and 50-58* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7,8,19-27,79 and 84-124* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 4, 5, 7, 8, 19, and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kutsch (6149895) in view of Roggenkamp (US 4448307) and Knudson (3936936). Kutsch shows a method for providing light activated tooth whitening, however, does not show simultaneously administering to more then one patient. Roggenkamp teaches that it is known that dentist simultaneously provide treatment to more than one patient, column 1, lines 21-28. It would be obvious to one of ordinary skill in the art to modify Kutsch to include simultaneously providing treatment to more than one patient as shown by Roggenkamp in order to more efficiently provide patient treatment. The above combination teaches using different rooms, however, does not specifically teach workstations. Knudson shows different workstations. It would be further obvious to one of ordinary skill in the art to modify the above combination to include workstations as shown by Knudson in order to better service the patient. The above combination teaches working on the patients practically simultaneously, however, does not specifically teach simultaneously. Knudson teaches that it is known to work on another patient during a wait time of a method being

preformed on the first patient, column 1, lines 12-15, as is well known in the art, for example the well known method of filling a cavity that includes the step of administering anesthetic and waiting to the anesthetic to take hold. It would be further obvious to modify the above combination to include simultaneously working on more than one patient as shown by Knudson. As to claim 2, Kutsch suggests evaluating tooth stains, column 1, lines 11-24. Evaluating a patient before any procedure is an obvious and well known step in treating patients. As to claims 7 and 8, see column 11, lines 43 and 44 of Kutsch. As to claims 23-25, the productivity coefficient depends on the times required to whiten teeth which are known in the art to depend on the process and whitener used and on the interpretation of the patient and/or doctor as to how much whitening is desired, therefore, the specific time required is an obvious matter of choice to the skilled artisan. As to claim 26, the use of an examination chair in dental application is well known.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kutsch (6149895) in view of Roggenkamp (US 4448307) and Knudson (3936936) as applied to claim 2 above, and further in view of Migurski et al (US 5964065). The above combination does not show evaluating at a location physically removed from the workstations. Migurski teaches evaluating patients at removed locations, column 5, lines 45-54. It would be further obvious to one of ordinary skill in the art to modify the above combination to include evaluating at a removed location as shown by Migurski in order to more efficiently service patients.

Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kutsch (6149895) in view of Roggenkamp (US 4448307) and Knudson (3936936) as applied to claim 1 above, and further in view of Cornell 5032178). The above combination does not show a specific time period. Cornell shows a time period of 5-15 minutes, column 3, line 44. It would be obvious to one of ordinary skill in the art to modify The above combination to include a time period as shown by Cornell in order to treat the teeth within known time periods. The specific time period used is an obvious matter of choice in the degree of a known parameter to the skilled artisan.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kutsch (6149895) in view of Roggenkamp (4448307) and Knudson (3936936) as applied to claim 8 above, and further in view of Prencipe et al (5698182). The above combination does not show the use of flavoring. Prencipe teaches using flavoring in a dentifrice, column 4, lines 29-37. It would be obvious to one of ordinary skill in the art to modify the above combination to include flavoring as shown by Prencipe in order to make the composition more pleasant for the patient.

Claims 79, 85, 86, 89, 90, 92, 100-109 and 115-123 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell (5032178) in view of Nikodem (5813854), Kutsch (6149895) and Knudson (3936936). Cornell teaches applying a light activated whitening gel to teeth and applying light, column 1, lines 17-39. Cornell does not show

applying the gel to all cosmetically visible teeth and does not show applying light to all said teeth simultaneously. Nikodem teaches simultaneously applying light to a plurality of teeth to reduce the time of the procedure, column 1, lines 60-67, and further teaches that the method can be used for whitening teeth, column 1, lines 54-58. It would be obvious to one of ordinary skill in the art to modify Cornell to include simultaneously whitening teeth as taught by Nikodem in order to reduce the time required. The above combination does not show repeating the method steps. Kutsch teaches repeating method steps three or five times for whitening teeth, column 15, lines 46-53. It would be obvious to one of ordinary skill in the art to modify the above combination to include repeating the method steps in order to achieve the desired results. The above combination does not show using workstations to treat more than one patient. Knudson teaches workstations 37. It would be obvious to one of ordinary skill in the art to modify the above combination to include workstations as shown by Knudson to more efficiently treat patients. As to claims 84 and 85, Cornell shows using a time period of 5-15 minutes, column 3, line 44. The specific time range used is an obvious matter of choice in the degree of a known parameter to the skilled artisan. As to claim 89, Kutsch teaches priming the teeth, column 11, lines 43 and 44. As to claims 103-109, Cornell teaches using manganese sulfate as a photosensitizing agent. The specific photosensitizing agent used is an obvious matter of choice in known agents to one of ordinary skill in the art. As to claims 115-123, Knudson shows the use of a chair 37. The use of trays in dental procedures is well known. The above teaching of a method of light activated teeth whitening obviously teaches using a light source and the use of

known supplies for whitening teeth. Storing a whitening gel in a separate container is well known in order to prevent premature activation. Sterilizing dental equipment is well known in order to prevent infections. The specific type of light source used is an obvious matter of choice in well known light sources to the skilled artisan.

Claims 87 and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell (5032178) in view of Nikodem (5813854), Kutsch (6149895) and Knudson (3936936) as applied to claim 79 above, and further in view of Yarborough (5713738). The above combination does not show isolating the gingival tissue. Yarborough teaches isolating gingival tissue, column 2, lines 40-54. It would be obvious to one of ordinary skill in the art to modify the above combination to include isolating gingival tissue as shown by Yarborough in order to protect the gums.

Claim 91 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell (5032178) in view of Nikodem (5813854), Kutsch (6149895) and Knudson (3936936) as applied to claim 79 above, and further in view of Murljacic (5766006). The above combination does not show using a shade guide. Murljacic teaches using a shade guide to compare color, column 1, lines 31-36. It would be obvious to one of ordinary skill in the art to modify the above combination to include using a shade guide as shown by Murljacic in order to determine the whiteness of the teeth.

Claims 93-99 and 110-114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell (5032178) in view of Nikodem (5813854), Kutsch (6149895) and Knudson (3936936) as applied to claim 79 above, and further in view of Pellico (5928628). The above combination does not show using the claimed percentage of hydrogen peroxide. Cornell teaches the use of hydrogen peroxide. The above combination does not show using the claimed range of hydrogen peroxide. Pellico shows using 7% - 30%, preferably 11% - 22% hydrogen peroxide, column 4, lines 1-8. It would be obvious to one of ordinary skill in the art to modify the above combination to include the percentages as shown by Pellico in order to make use of art known percentages for whitening teeth. The specific range used is an obvious matter of choice in the degree of a known parameter used to the skilled artisan. As to claims 110-112, Pellico shows using a desensitizing agent, column 4, lines 37-43. It would be obvious to one of ordinary skill in the art to modify the above combination to include the use of a desensitizing agent as shown by Pellico in order to make the procedure more comfortable. The specific desensitizing agent used is an obvious matter of choice in known agents for obtaining a known result to one of ordinary skill in the art. As to claims 113 and 114, the above combination does not show the use of a flavoring agent. Pellico teaches using flavoring in a whitening gel, column 4, lines 47-51. It would be obvious to one of ordinary skill in the art to modify the above combination to include a flavoring agent as shown by Pellico in order to improve the comfort and sensations of the patient.

Priority

Applicant's claim for domestic priority, which it is assumed was made under 35 U.S.C. 120 is acknowledged. However, application 09/651,170 was filed August 30, 2000 while the present application was filed January 14, 2000. Priority cannot be claimed for an application that was filed after the application that is attempting to claim the priority. Therefore, the priority to the 09/234,038 application, which is linked by the '170 application is also not granted. Applicant must correct or delete the claim from the specification.

Response to Arguments

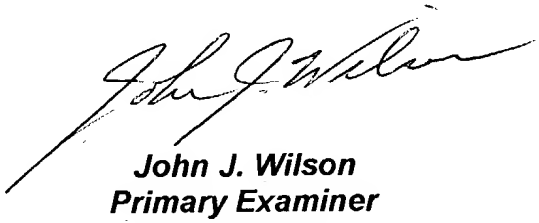
Applicant's arguments filed February 27, 2004 have been fully considered but they are not persuasive. With respect to Murljacic not showing light activated, Kutsch has now been used which does show light activated. With respect to simultaneous treatment, the applied rejection above treats more than one patient at a time within the bonds of the several method steps being applied to the patients. The above combinations solve the problems of efficiently treating patients, and therefore, suggest the combination. Applicant is required to check the priority data, see above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to John Wilson at telephone number (703) 308-2699.



John J. Wilson
Primary Examiner
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April 16, 2004
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